

## REMARKS

Claims 7-11 and 15-26 are currently pending. Claims 7-11 and 15-26 have been rejected. Claims 7, 16, and 20 have been amended to further particularly point out and distinctly claim the subject matter regarded as the invention. No new matter has been added.

### Claim Rejection 35 U.S.C. 102(b)

Claims 7, 15, 16, 21 and 22 stand rejected under 35 U.S.C. 102(e) as being allegedly anticipated by US Patent 6,161,034 issued to Burbank et al. Claims 7, 16, and 22 are independent claims. This rejection is respectfully traversed.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup>

The office action states:

“Burbank discloses a method for performing a biopsy comprising removing tissue from a vascular site (Column 6 lines 7-38) and positioning a pledget of absorbable sponge material adjacent the vascular tissue site wherein the absorbable sponge material includes a contrasting agent substantially dispersed throughout said pledget (Column 5 lines 29-46).”

Applicant respectfully disagrees. Upon a closer reading of Burbank, including the citation provided by the Examiner, Burbank does not teach each and every element as set forth in Claims 7, 16, and 22. Amended Claim 7 provides for:

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<sup>1</sup> Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

“positioning a pledget of absorbable sponge material adjacent the vascular tissue site wherein the absorbable sponge material includes a contrasting agent substantially dispersed throughout said absorbable sponge material.”

Amended Claims 16 and 22 provide for a similar limitation.

As stated in the Specification, the “contrasting agent [is] incorporated in the matrix of the sponge. By ‘incorporated’, [it] is meant that the contrasting agent is substantially dispersed throughout the sponge so that the contrasting material is not simply found on the periphery of the sponge. The sponge is made by mixing a suitable organic solvent (e.g., formaldehyde) with an aqueous solution of gelatin. The organic solvent facilitates the cross linkage of gelatin polymers. ... Subsequently, a contrasting agent is added and the resulting mixture beaten to produce a firm foam. Thereafter, the foam is dried to produce the absorbable sponge material.” (Specification, page 7, lines 26-29 and page 8, lines 1-8). Thus, the contrasting material is substantially dispersed throughout the sponge such that the sponge already contains the contrasting agent in a stable form and does not require additional material to contain or encase the contrasting agent.

Burbank teaches the use of “a) a detectable (e.g. imageable palpable, energy-emitting and/or visible) substance ... in combination with b) a clearance limiting element (e.g., a diffusion-limiting polymer matrix, a membrane or liposomal encapsulation, a biodegradable matrix or encapsulant, etc.) that will limit the dissolution, biodistribution and/or local metabolism of the detectable substance.” (Col. 5, lines 30-40). In essence, Burbank utilizes a detectable substance that must be used in combination with an encasement to enclose the

detectable substance to limit dissolution of the detectable substance. Furthermore, Burbank does not teach having the detectable substance substantially dispersed throughout an absorbable sponge material as claimed in Claim 7, 16, and 22. Accordingly, Burbank does not teach incorporating the contrasting agent throughout a sponge material as claimed in the present invention.

Thus, for this reason, among others, since Burbank does not teach “a contrasting agent substantially dispersed throughout said absorbable sponge material” as claimed in Claims 7, 16, and 22 it can not be said to anticipate the claimed invention. It is respectfully requested that this rejection be withdrawn.

### **Dependent Claims**

Dependent Claims 8-11, 15, 17-21, and 23-26 all depend from independent Claims 7, 16, or 22. The argument set forth above, among others, is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

**Summary**

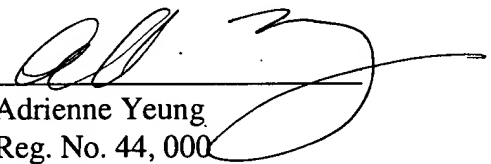
It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
THELEN REID & PRIEST LLP

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